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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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J. Michael Neary

Date

Inventor: Gabrys and Simmons)
Serial No.: 09/630,157) Group Art Unit: 3682
Filed: July 31, 2000) Examiner: Chong H. Kim
Title: "Flywheel Hub-to-Rim Coupling")

January 2, 2003 FAX RECEIVED

Petition under Rule 181

JAN 02 2003

Commissioner for Patents
Washington, DC 20231

OFFICIAL

GROUP 3600

Sir;

Applicants respectfully petition for entry of the Amendment under Rule 116 filed in this Application on Oct. 7, 2002, and for entry of the Affidavit by Dennis Simmons filed on that same date.

In a Final Office Action dated June 7, 2002, all pending claims 1-8 and 10-20 were rejected under 35 USC 112 for insufficient disclosure. In paragraph 7 of the Final Office Action, the Examiner invited Applicants to submit evidence to show that know-how exists, without extensive research by the manufacturing industry, to follow the teachings in the specification to produce the claimed invention, thereby overcoming the §112 rejection set forth in paragraph 1 of the Final Office Action. The Affidavit, with Exhibit A, illustrates and explains the information that is available from suppliers and the open literature about the characteristics of materials used in modern flywheels, and shows how that information is applied in accordance with the teaching in the specification to produce a flywheel rim-hub coupling in accordance with the invention.

Specifically, the affidavit illustrates an example of the data that is available from suppliers about the materials they sell, and other open literature sources, and shows how that data is used to make the simple calculations to ensure that the rim liner always remains in compressive contact with the rim.

In the Final Office Action, claims 7, 8 and 10-20 were rejected under 35 USC 112 as indefinite for the presence of a term in claim 7 lacking antecedent basis, and for "relative terms" in the other claims. The Examiner helpfully suggested that Applicants could cure these defects by deleting "high speed" and "maximum speed" from claims 7, 10, 13, 15 and 18 to remove the grounds for the §112 rejection of claims 7, 8 and 10-20. Applicants Rule 116 Amendment complied with that suggestion.

Claim 7, was rejected in the Final Office Action under 35 USC 102 as anticipated by Kundermann. The Rule 116 amendment attempted to amend this claim to insert the subject matter of allowable claim 3 (after resolution of the §112 issue), specifically claiming the relationship between the characteristics of the rim liner and the rim that allow growth of the rim liner radially into the rim to maintain compressive contact with the rim throughout operation of the flywheel.

In an Advisory Action dated Oct. 30, 2002, the Examiner refused to enter Applicants' Rule 116 Amendment because the amendment to claim 7 raised new issues that would require further consideration and/or search, and did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The "new issues that would require further consideration and/or search" are identified by the Examiner in the Continuation Sheet to the Advisory Action as follows:

The amended claim 7 reciting that the rim liner is disposed inside the rim and the rim having such characteristics raise new issues that would require further consideration and/or search.

In response to a Request for Reconsideration filed by Applicants on Nov. 7, 2002, the Examiner expounded on his grounds for refusing to enter the Rule 116 Amendment as follows:

The proposed change to claim 7 raises new issues with respect to the subject matter defined by claim 7, accordingly the amendment filed October [sic] 7, 2002 will not be entered.

Applicants respectfully assert that the addition of the limitation that the rim liner is "inside said flywheel rim" is not a new issue and was already searched and considered by the Examiner in his consideration of original and amended claim 15, which called for an annular rim liner engaged with the inner circumferential surface of an annular rim. Claim 15, as originally filed, calls for

15. A flywheel system, comprising:
a hub;
a flywheel rim concentric on said hub having a carbon fiber/epoxy outer annulus and, contiguous therewith, an E-glass inner annulus with an inner circumferential surface;
a rim liner engaged with said inner circumferential surface of said inner annulus;
said rim liner being made of a material that grows radially with said rim and has sufficient strength to transmit torque between said rim and said hub during flywheel spin-up and during energy recovery from said flywheel; and
a torque coupling between said hub and said rim liner that allows said liner to grow radially with respect to said hub while remaining concentric thereto during high speed operation.

This claim 15 does not specifically say, in so many words, that the rim liner is "inside said flywheel rim", but there is no other possible logical interpretation to the third limitation, emphasized in bold above.

The limitation, that the rim liner is "inside said flywheel rim", proposed in Applicants' Rule 116 amendment to claim 7 that the Examiner finds to offend the rule against introducing amendments after final that raise new issues or require further consideration and/or search was added merely to provide antecedent basis for the primary limitations copied from claim 3, which is allowable over the prior art but was rejected only under §112.

Applicants believe that entry of their proposed Rule 116 Amendment would greatly simplify the issues for appeal. It resolves the two §112 rejections and includes subject matter in claim 7 that has been found to be allowable in claim 3. The only addition to the subject matter from allowable claim 3, the limitation that the rim liner is "inside said flywheel rim", is a further limitation to subject matter that has already been found to be allowable, and is only in the claim to provide the relational context for the growth of the rim liner into the rim, as claimed in the later part of claim 7.

Accordingly, Applicants believe that entry of this amendment and the attached affidavit, would greatly simplify the consideration of this Application by the Board of Appeals and would also greatly simplify the work of the Examiner and the Appeal Conference in considering whether to prepare an Examiner's Answer to Applicants' Appeal Brief or to pass this Application to issue.

Respectfully submitted,



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